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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,399	11/29/2000	William A. Fuss	D/99820690-009488-US(PAR)	742

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EXAMINER
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NAKHJAVAN, SHERVIN K

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/725,399

Applicant(s)

FUSS ET AL.

Examiner

Shervin Nakhjavan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Response to Arguments***

1. Applicant's arguments, see pages 8-10 of the amendment, filed 10-30-03, with respect to the rejection(s) of claim(s) 1-29 under 35 U.S.C 102 and 103, wherein the first location and second location are not in one disclosure, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art that teaches the first location and second location not enclosed within a same disclosure.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6-11, 13-15, 17-19, 20, 23, 25-27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Sonoda et al. (US 6,014,453).

Regarding claim 1, Sonoda teaches, a process comprising: detecting at a first location if a video signal represents a selected type of image (Column 23, Lines 59-66, where the computer 110 performs the detecting at first location, by image processing device 200 of the kind of image data, in order to determine if the image or video data represents a selected type of image by acknowledging counterfeiting action based upon

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the probability judging of the image in the processor 200); receiving said video signal at a second location not in the same disclosure as said first location (Column 23, Line 64 through Column 24, Line 1, where the printer 120 is the second location to receive the video signal that is not in the same disclosure as the first location); and printing an image from said video signal at said second location if said video signal does not represent said selected type of image (Column 23, Line 64 through Column 24, Line 2, if it is determined that there is no counterfeiting is being done the video signal is sent to second location, printer 120 to be printed);

Sonoda teaches limitation of claim 2, said selected type of image represents a member of a group consisting of currency and negotiable securities (Column 13, Line 63 through Column 14, Line 4);

Sonoda teaches limitation of claim 3, said detecting step comprises scanning an object at said first location to produce said video signal (Column 23, Lines 47-58, where the detecting is performed by the image processor 200 located at the scanner side 100 which scans the document before said detecting);

Sonoda teaches limitation of claim 6, process further comprising taking corrective action if said video signal represents said selected type of image (Column 23, Line 64 through column 24, Line 3, where upon detecting of counterfeiting, the corrective action is to modify the image by turning it into black or reducing it);

Sonoda teaches limitation of claim 7, said corrective action comprises invalidating said video signal (Column 23, Lines 61-66, wherein the outputting of the "modify image" command is the invalidating of the video signal);

Sonoda teaches limitation of claim 8, said corrective action comprises stopping said printing step (Column 23, Line 64 through column 24, Line 3, wherein upon receiving the "modify image" command, the printer stops the print process of the original image by blackening or reducing the original);

Sonoda teaches limitation of claim 9, said stopping step prevents printing even a partial image (Column 23, Line 64 through column 24, Line 3, turning the image black is the stop printing of even partial image which is the reduced version).

Sonoda teaches limitation of claim 10, process further comprising: adding to said video signal a validation code at said first location if said video signal does not represent said selected type of image, and checking at said second location for said validation code (Column 24, Lines 35-37, where the other device is located in a second location not in the same disclosure of the first fax machine, and upon receiving of the transmitted image data at the second location being an also a fax machine, the probability data which is the validation code is also received and checked for validating the printing process at the second fax machine location);

Sonoda teaches limitation of claim 11, said adding step comprises adding a validation code, said code being separate from the video signal (Column 24, Lines 35-37, where the probability data is sent separate from the video data);

Sonoda teaches limitation of claim 13, an apparatus comprising: a detector at a first location for determining if a video signal represents a selected type of image (Column 24, Lines 27-34, where the transmitting fax machine at first location detects the probability of counterfeiting act); and a corrector at a second location taking corrective

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act if said video signal represents said selected type of image, said locations not being in the same enclosure (Column 24, Lines 35-37, where upon receiving the probability data and the video data at the remote or second fax machine location, the remote machine corrects the video data by modifying it if it is determined that the image is part of a counterfeiting act (as discussed with reference to claim 1 above) in other words the image received being the image of a currency which is prohibited for printing);

Sonoda teaches limitation of claim 14, said corrector comprises an adder adding a validation code to said video signal if said video signal does not represent said selected type of image, said adder being disposed at said first location (Column 24, Lines 35-37, where the adder of the probability data or the validation code is at the transmitting fax before transmission of the video data);

Sonoda teaches limitation of claim 15, said adder adds a validation code, said code being separate from the video signal validation code (Column 24, Lines 35-37, where the probability data is sent separate from the video data by attachment);

Sonoda teaches limitation of claim 17, said corrector comprises an invalidator altering said video signal (Column 24, Lines 35-37, where the image modifier is the invalidator in the remote device);

Sonoda teaches limitation of claim 18, said selected type of image represent a member of a group consisting of currency and negotiable securities (Column 13, Line 63 through Column 14, Line 4);

Sonoda teaches limitation of claim 19, apparatus further comprising; a scanner scanning an object to provide said video signal (Column 24, Lines 27-30, where scanners reside in fax machines inherently);

Sonoda teaches limitation of claim 20, an apparatus disposed at a second location for receiving a video signal from a first location, said locations not being in the same enclosure, said apparatus comprising: a detector receiving said video signal and determining the presence of a validity code (Column 24, Lines 35-37, where the remote device or fax receives the video data along and detects the probability data as a validity code); and a printer printing a reproduction of said video signal only when said validity code is present (Column 24, Lines 27-37, where in an alternative embodiments of lines 35-37, upon receiving validity code or the probability data corresponding to an image reproducing command that is not part of a counterfeiting act i.e. reproducing currency, the fax printer prints the image data);

Sonoda teaches limitation of claim 23, said printer does not print even a partial image if said video signal represents a selected type of image (Column 24, Lines 35-37, where modifying includes blackening of the image completely as discussed in claim 9 above);

Sonoda teaches limitation of claim 24, said video signal is receive from a separate location (Column 4, Lines 10-17, where image sensor 30 is located next to the first processing unit 10);

Sonoda teaches limitation of claim 25, a xerographic printer disposed at a second location comprising (while second location has been given weight, the xerographic

printer has not been given weight because it is not part of the body of the claim): at least one station applying a video signal from a first location to a member, said locations not being in the same enclosure (Column 23, Lines 59-64, wherein Interface unit 113 is the station located in the first location being part of assembly 110 and item 122 is being the member); and an image processor receiving said video signal and providing it to said station only when a validation code is present (Column 23, Lines 59-65, where upon receiving the video data at the image processor 200, the video data will only proceed to the station 113 only if the probability data or the validation data to do so is present i.e. being a data or a code that does not belong to a counterfeiting act category);

Sonoda teaches limitation of claim 26, said validation code is present only when said video signal does not represent a member of a group consisting of currency and negotiable securities (Column 23, Lines 62-66, where the validation code or the probability data to for printing of the video data is inherently a code or probability data produced by item 200 that is not one of the non-reproducing image probability data such as video data discussed at Column 13, Line 63 through Column 14, Line 4);

Sonoda teaches limitation of claim 27, said processor does not provide even a partial video signal when said code is not present (Column 23, Line 64 through column 24, Line 3, where the video data would be all black when printed);

Sonoda teaches limitation of claim 29, the printer further comprising a plurality of stations each of said stations receiving a color component signal of said video signal (Column 18, Line 66 through Column 19, line 18, where separate stations of a color printer including detection of color components, are discussed).



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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al. in view of Roller (US 5,850,581).

Regarding claims 4, 5, 21 and 22, Sonoda teaches limitations of the claims substantially however, Sonoda does not specifically teach the printing steps being xerographically or by inkjet. Roller teaches, limitation of claims 4 and 21, said printing step comprises xerographically printing (Column 1, Lines 12-21);

limitation of claims 5 and 22, said printing step comprises ink jet printing (Column 1, Lines 23-28).

It would have been obvious to an ordinary skilled in the art to use xerographical or inkjet printing capabilities of Roller with Kai's system because xerographical printing is cost effective when only black color is used and when printing in multiple colors ink jet printing is more cost effective.

6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al. in view of Lang et al. (US 5,493,381).

Regarding claim 28, Sonoda teaches number of limitations of the claim however, Kai does not specifically teach processing components of claim 28. Lang teaches, said

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station includes a scanner coupled to said processor, a drum disposed proximate said scanner, a development station disposed proximate said drum, and cleaner disposed proximate said drum (Column 2, Lines 46-67, where the scanner station B is coupled to the drum or belt 10, development station C is coupled to the drum 10, a cleaner station F is coupled to the drum 10). It would have been obvious to an ordinary skilled in the art to utilize the cleaning technique of Lang before printing because it facilitates in removing toner and additive film particle buildup on the photoconductive (i.e. imaging) member.

7. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonoda et al..

Regarding claims 12 and 16, while Sonoda fails to specifically teach adding of the validation code by embedding of the validation code in the video signal, Sonoda clearly teaches adding the validation code or probability data to the video signal by attaching it to the video data (Column 24, Lines 35-37). Absent some showing of criticality or unexpected results, the exact adding process used is believed to be within the skill level of ordinary practitioner in this art, who would find it obvious to choose the most appropriate validation process for printing purposes for a given application.

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shervin Nakhjavan whose telephone number is (703) 306-5916. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached at (703) 305-4706.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, DC 20231

**Or faxed to:**

(703) 872-9306 for *formal* communications, please mark "EXPEDITED PROCEDURE"

or:

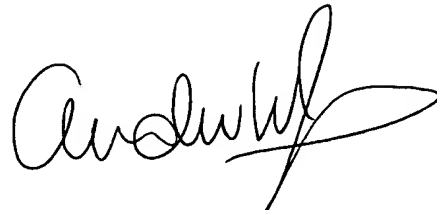
for *informal* or *draft* communications; please label "PROPOSED" or "DRAFT".

**Hand delivered responses** should be brought to Crystal Park 2, 2121 Crystal drive, Arlington, VA, sixth floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Tech center 2700 customer service office **(703) 306-0377**.

Shervin Nakhjavan *S.N*  
Patent Examiner  
Group Art Unit 2621  
March 25, 2003.



**ANDREW W. JOHNS  
PRIMARY EXAMINER**